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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sutkowski & Washkuhn Ltd.

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Serial No. 75/643,089

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Steven P. Oates for Sutkowski & Washkuhn Ltd.

Darlene D. Bullock, Trademark Examining Attorney, Law  
Office 111 (Craig Taylor, Managing Attorney).

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Before Seeherman, Quinn and Drost, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sutkowski & Washkuhn Ltd. has appealed from the final  
refusal to register BUSINESS LAW FIRM, in the stylized form  
shown below, and with a disclaimer of the words BUSINESS  
LAW FIRM, for "legal services."<sup>1</sup> The letters in the word

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<sup>1</sup> Application Serial No. 75/643,089, filed February 16, 1999,  
and asserting first use and first use in commerce on  
September 22, 1998.

"business" appear in the color blue. Registration has been refused pursuant to Section 2(e)(1) on the ground that the mark is merely descriptive of the services.

**BUSINESS** *lawfirm*

Applicant and the Examining Attorney have filed appeal briefs. An oral hearing was not requested.

Before we reach the substantive issue, we must provide some background regarding the examination of this application. The initial drawing filed by applicant showed the stylized mark depicted above, but with the word BUSINESS superimposed over five horizontal lines.

Applicant had intended these lines to indicate that the word BUSINESS was depicted in the color blue, but because this was not the proper manner in which to show color lining, the Examining Attorney understood the mark to be the words BUSINESS LAW FIRM with a design consisting of horizontal lines. It was not until the Examining Attorney received applicant's appeal brief that she learned the actual nature of applicant's mark, a fact which she acknowledged in her appeal brief. At that point the file was transmitted to the Board for a decision on the appeal, but because of the confusion about the nature of the mark

during examination, the Board remanded the application to address such questions as the adequacy of the drawing, description of the mark, and adequacy of the specimens. The Examining Attorney then issued an Office action in which, inter alia, she withdrew her acceptance of the applicant's disclaimer of BUSINESS LAW FIRM, stating that such a disclaimer would result in the disclaimer of the mark as whole, and that an entire mark may not be disclaimed. Applicant argued against this withdrawal in its response to the Office action, and it appears that the argument was successful, because in the following action the Examining Attorney did not mention the disclaimer at all, and with respect to the refusal, stated only that "the final refusal to register under Section 2(e)(1) is maintained and the file is returned to the Trademark Trial and Appeal Board for resumption of the appeal." Action mailed July 1, 2002.

That is the current posture of the case. Because the only issue on appeal is whether the stylized mark is merely descriptive, and that issue was previously briefed, we have not found it necessary to allow supplemental briefing.

This brings us to the question of whether applicant's mark, BUSINESS LAW FIRM in stylized format, is merely descriptive of legal services. There is no question that

the words BUSINESS LAW FIRM are merely descriptive of these services. Applicant has conceded this by its disclaimer of the words BUSINESS LAW FIRM. Indeed, applicant has insisted on the disclaimer of these words. In any event, the Examining Attorney has submitted substantial evidence that "business law firm" is a merely descriptive, if not a generic term, for legal services. See, for example, the following excerpts taken from the NEXIS database:

Alan G. Churchmack has joined the  
Cleveland business law firm and will  
practice employment law and real  
estate.

"The Plain Dealer," March 23, 2000

The business law firm of Litow, Cutler  
& Zabloudowski opened a law office....

"Sun-Sentinel (Fort Lauderdale, FL),"  
March 20, 2000

Duckson & Carlson LLC, Minneapolis, a  
business law firm....

"Star Tribune (Minneapolis, MN),"  
March 19, 2000

Applicant argues, however, that its mark includes a distinctive design, namely, "the three words 'business law firm' are written all as one word, with a distinctive font design and color for the letters 'business.'" Brief, p. 4. It is true that when words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed. **In re**

**Clutter Control, Inc.**, 231 USPQ 588 (TTAB 1986), and cases cited therein. The question thus becomes whether the manner in which these descriptive words are depicted is so unique that the mark as a whole is inherently distinctive, that is, whether the features of the display are of such a nature that they would inherently serve to distinguish the mark in its entirety. See **In re Pollio Dairy Products Corp.**, 8 USPQ2d 2012 (TTAB 1988). Unique in this sense does not mean one and only, but means highly unusual or extraordinary. See **In re E S Robbins Corp.**, 30 USPQ2d 1540 (TTAB 1992).

We find that the stylization of applicant's mark is not sufficient to render the mark as a whole inherently distinctive. The lettering in applicant's mark, and the fact that the word BUSINESS is shown in blue, does not make the stylization highly unusual. Even applicant does not argue that the type font in which the generic term LAW FIRM is shown, an ordinary italic font, is distinctive. Although the word BUSINESS is in a different font, and in the color blue, neither this font nor color is unusual enough to make a striking commercial impression. Nor does running together the words BUSINESS LAW FIRM into BUSINESSLAWFIRM serve to change this merely descriptive if not generic term into a suggestive mark. Certainly the

stylization of applicant's mark does not rise to the level of distinctiveness found in the Clutter Control case, in which the Board pointed to the tube-like rendering of the letter C in CONSTRUCT-A-CLOSET, with each "C" creating an enclosure for the rest of the letters forming each word.

Finally, applicant points out that after it filed its response to the first Office action, the application was approved for publication, but that this determination was reconsidered two weeks later. This initial determination of registrability by the Examining Attorney has no persuasive value to us, particularly given that at the time the determination was made, the Examining Attorney was unaware of what applicant's actual mark was.

Decision: The refusal of registration is affirmed.